

REMARKS/ARGUMENTS

In response to the Office Action mailed September 29, 2005, Applicants propose to amend their application and request reconsideration in view of the following remarks. No claims are cancelled in this Amendment and no claims are added. Therefore, claims 1, 2, 7-9, 11-15, 17-19, 22-25, 27-33, and 35-44 remain pending. The listing of claims pending in this application both in the PTOL-328 Form and within the Office Action continues to contain numerous errors. The listing of pending claims in this paragraph is correct.

In this Amendment an error in the previously presented claims is corrected. Essentially, the correction is of a typographical nature, the wrong tense having been used in adding paragraphs to the independent claims. In the game according to the invention, a determination is made as to whether a shift is to be made to a special game state. The first random number is generated when a determination is made that a shift will occur to the special game state but before that shift has actually occurred. In preparing the claims for examination in response to the Office Action mailed May 13, 2005, an error was made in the added claim language and that error is corrected here. The substance of the claims pending is not affected by this correction and, therefore, the corrected claims should be entered.

In response to the amendment filed August 8, 2005, the Examiner made new rejections of all pending claims. As best understood, the outstanding rejections are as follows.

Claims 1, 2, 7-9, 11, 18, 19, 23-25, 27-32, and 44 are rejected as unpatentable over Ugawa (Published Japanese Patent Application 9-56896) in view of Kodachi '875 et al. (U.S. Patent 6,143,875, hereinafter Kodachi '875).

Claims 12-15, 17, 22, 33, and 35-43 were rejected as unpatentable over Ugawa in view of Fuchs (U.S. Patent 5,630,753), and further in view of Kodachi '875.

It is apparent that Kodachi '875 is critical to the rejection of all claims. However, Kodachi '875 is not prior art under U.S. law to the present patent application. Therefore, each of the rejections is legally defective and cannot properly be maintained.

In the Office Action mailed October 6, 2003 in this patent application, one of the references relied upon was Kodachi '874 et al. (U.S. Patent 6,142,874, hereinafter Kodachi '874). It is apparent, because of their consecutive numbers, that Kodachi '874 and Kodachi '875 were simultaneously issued. Their first pages indicate common assignment to Aruze Corporation, the assignee of the present patent application. The comments supplied in the Amendment filed January 6, 2004 with regard to Kodachi '874 apply with respect to both of Kodachi '874 and Kodachi '875. Accordingly, those comments, edited to refer to both of Kodachi '874 and Kodachi '875, are reproduced below.

The rejection is legally erroneous. Pursuant to 35 U.S.C. 103(c), neither Kodachi '874 nor Kodachi '875 can be prior art to the present patent application.

The present patent application is a national phase application of an international patent application, PCT/JP00/05693 filed in Japan on August 24, 2000. Thus, the effective filing date of the present patent application is August 24, 2000, because the international application designated the United States. Moreover, the international application claims the priority of the two Japanese national patent applications identified in the Declaration of this patent application. Those Japanese national applications were filed on August 31, 1999. With the Amendment filed January 6, 2004 in the prosecution of this patent application, Applicants submitted certified English language translations of their Japanese national patent applications 11-244279 and 11-244280, perfecting, pursuant to 37 CFR 1.55(a), their filing date of August 31, 1999, as the effective filing date of the present patent application.

Kodachi '874 and Kodachi '875 issued as U.S. patents on November 7, 2000 with U.S. filing dates of May 25, 1999. Bearing in mind the effective filing date of the present patent application, it is apparent that neither of Kodachi '874 and '875 can be prior art pursuant to 35 U.S.C. 102(a), because neither Kodachi '874 nor '875 was patented or a printed publication in this or a foreign country before the effective filing date of the present patent application. For the same reason, it is even more apparent that neither of Kodachi '874 or '875 can be prior art pursuant to 35 U.S.C. 102(b). In fact, the only

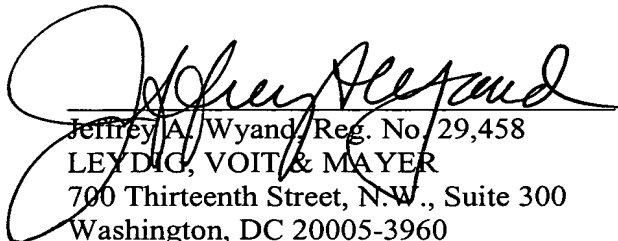
subsection under which either of Kodachi '874 or '875 can be prior art is 35 U.S.C. 102(e).

The present patent application is assigned, pursuant to an assignment recorded in the records of the U.S. Patent and Trademark Office at reel 12042, frame 156, to Aruze Corporation. Both of Kodachi '874 and '875 are likewise assigned to Aruze Corporation. Thus, 35 U.S.C. 103(c) applies. Pursuant to that subsection, Kodachi '875 cannot be applied as prior art against any claim of the present patent application. Therefore, the prior art rejection based upon Kodachi '875 must be withdrawn.

Because Kodachi '875 is not prior art to the present patent application and because every new rejection, i.e., all pending rejections, depends for its propriety upon Kodachi '875 being prior art, those rejections are legally erroneous and must be withdrawn.

Upon the withdrawal of the rejections, all remaining claims, claims 1, 2, 7-9, 11-15, 17-19, 22-25, 27-33, and 35-44 should be allowed, bringing to an end the extended prosecution of this patent application.

Respectfully submitted,


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